

REMARKS

The present response is to the Office Action mailed in the above-referenced case on May 24, 2004, as a first and non-Final action in re-opening or prosecution after appeal. Claims 2-10 and 12-18 are pending for examination.

The Examiner has objected to the amendment filed 4/9/03 as under 35 U.S.C. 132 as introducing new matter into the disclosure, indicating that the added material is essentially the language of claim 1. Further, claims 10 and 13 are objected to informally as each having a term not supported by antecedent. Still further claims 2-18 are rejected under 35 U.S.C. 112 as claiming subject matter not supported in the specification, indicating the Examiner's opinion that the original specification only briefly describes IPNT capability. In addition claim 10 and 13 are rejected under 35 U.S.C. 102(e) over Rogers et al. (of record), and claims 2-10 and 12-18 are rejected under 35 U.S.C. 103 over Rogers in view of Andrews (of record).

In the matter of the objection to the amendment of 4/9/03 as introducing new matter, the applicant respectfully urges that the matter objected-to was not introduced in that amendment, but had been in the case much longer, as early as the first amendment filed, and has never been objected to as new matter before in the long prosecution of this case. The applicant is still of the belief that none of this is new matter.

In the matter of the 112 rejection, the subject matter claimed is fully supported in the specification. The description in the specification is necessarily brief, because the subject of IPNT telephony is not new and is not claimed as new in the present application. All of the details of well-known internet telephony are available to the skilled artisan, and were so at the time of filing of the present application. What is new and not obvious at the time of filing is the application of intelligent routing to IP telephony in the manner described and claimed in the

present application. The details of routing intelligence are voluminously detailed in applicant's disclosure. The existence of point to point Internet telephony was known. The combination is new.

In the matter of the 102(e) rejection over Andrews, applicant reiterates his previous contentions that Andrews falls short of providing sufficient teaching to support a prima facie rejection under section 102. This is because, according to the courts, "It is axiomatic that anticipation of a claim under Section 102 can be found only if the prior art reference discloses every element of the claim." In re King, 801 F.2d 1324, 1326, 231 USPQ 136 138 (Fed. Circ. 1986). See also Lindemann Maschinenfabrik GMBH vs. American Hoist and Derrick, 730 F.2d 1452, 1458, 221 USPQ 481 485 (Fed. Circ. 1984).


In the matter of the 103 rejections, if it is axiomatic that a rejection under section 102 requires that every element of the claim be taught in the single reference, than of course the combined references in a 103 rejection must teach every element of the claim, with the added burden that motivation to combine the teaching must be found and supported in the art, not from applicants disclosure. The 103 rejections therefore fail as well.

Applicant believes independent claims 2, 10 and 13 as amended and argued above are therefore now patentable over the combined references. Claims 3-9, 12 and 14-18 are then patentable on their own merits, or at least as depended from a patentable claim.

As all of the claims standing for examination as amended have been shown to be patentable over the art of record, applicant respectfully requests reconsideration after final and that the present case be passed quickly to issue. If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due

beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Respectfully Submitted,
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